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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,151	08/24/2001	Sylvette Maisonnier	ESSR: 052US	3004

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EXAMINER	
TUCKER, PHILIP C	
ART UNIT	PAPER NUMBER
1712	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/939,151	MAISONNIER ET AL.	
	Examiner	Art Unit	
	Philip C Tucker	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-66* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-27,36,39,42-45,48-57 and 62* is/are rejected.

7)☒ Claim(s) *28-35,37,38,40,41,46,47,58-61 and 63-66* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 42-45 and 48-54 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-25471.

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed. Such is used to form substrates, such as a lens, which comprises a protective coating over the latex film (see the English translation of the JP document). Such would inherently have the same latex particle size as in the present invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 42-45, and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-25471 in view of the Declaration by Maisonnier under 37 CFR 1.132 in serial no. 09/991773 and Postle (4578305).

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed (see the English translation of the JP document). JP '471 differs from the present invention in that the size of the latex particles are not specifically disclosed. With respect to the declaration of Maisonnier, the teachings therein state that the typical latex formed by different methods of emulsion, still have a particle size of 150-250 nm. The utility of a latex with such size would thus be obvious to one of ordinary skill in the art. Furthermore, it would be obvious to one of ordinary skill in the art to vary the size of the latex particles in order to optimize the photochromic properties of the latex (In re Aller 103 USPQ 233, In re Rose 103 USPQ 237). Postle teaches that variation of the particle size of the latex in a photochromic latex will have a significant impact upon films formed thereby (see columns 5 and 6). The variation of the particle size of the latex of JP '471 in order to

obtain improved properties of the photochromic latex, would thus be obvious to one of ordinary skill in the art.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 24-27, 36, 39, 55-57 and 62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/991773. Although the conflicting claims are not

identical, they are not patentably distinct from each other because although 09/991773 differs by using the term primer instead of initiator, the method of the claims of 09/991773 uses the same components as in the present invention, and would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 28-35, 37, 38, 40, 41, 46, 47, 58-61 and 63-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's arguments have been considered but are not deemed persuasive. Applicant had requested that there be provided evidence of the latex within the range of 50 and 400nm, or evidence that a change in latex size would affect the photochromic latex properties. Applicant has argued that the Maisonnier declaration has been improperly used since it is not prior art. Case law such as **In re Wilson** 135 USPQ 442 has clearly held that a reference cited to show facts does not need to be available as prior art before applicants filing date. Since a declaration must contain truthful, i.e. factual evidence, this can clearly be used to establish facts, even though it is not available as prior art, in view of the teaching of Wilson. Maisonnier is a common inventor in each of the applications, and has provided factual evidence of the particle size. Maisonnier's declaration provides evidence for the latex having a particle size

within the specified range, and Poslte provides evidence that a change in particle size does affect the properties of the photochromic latex. Since applicants declaration has provided evidence that whichever method is used to form a typical latex, the particle size is within the scope of the present claims, the rejections under 35 USC 102 and 103 are maintained.

Applicant's amendment to claim 46, by removing the word "preferably" distinguishes over the JP reference, since the core/skin biphasic structure is not specifically disclosed.

With respect to the obviousness double patenting rejection, a miniemulsion is a type of emulsion, and renders the broad teaching of the emulsion of the current claims obvious to one of ordinary skill in the art. Furthermore, applicant has admitted in the arguments at the top of page 21 of the response, that there is an overlap of the same particle size as being claimed in the present invention. The obviousness double patenting rejection is thus maintained.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip C Tucker
Primary Examiner
Art Unit 1712